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In the United States Patent and Trademark Office Before the Board of Patent Appeals

This application has been made special.

Appn. Number: 09/832,440 Appn. Filed: 2001 April 11

Applicant: Steve Morsa Examiner: Jonathan Ouellette Art Group: 3629

Title: Method and Apparatus for the Furnishing of Benefits Information and Benefits

Express Mailing Certification

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Steve Morsa

Applicant/Appellant Reply Brief

In 10 Pages

This is in response to Examiner's Answer mailed 07/25/2008.

Applicant respectfully submits the following:

Inventions Patentable

"Whoever invents or discovers any new and useful process, machine, manufacture, or compositions of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title." 35 U.S.C. 101

For Board efficiency and expediency purposes; in light of Examiner's mailed 7/25/2008 Answer consisting in large part of matter from the most recent; mailed 7/17/2007 Office action, which action Appellant has previously addressed in his filed 5/14/2008 Appeal Brief; applicant will in this Reply Brief; where applicable and reasonably possible to do

so; refer to said Appeal Brief (hereinafter *Brief*) when addressing various of Examiner's contentions, arguments, etc.

1. Re Examiner's Answer (hereinafter *Answer*) p.2-3; *Summary of Claimed Subject Matter*:

A. To clarify; summary for each of the three claim groups are as follows:

(i) Claims 181, 184, 188-203, 206, 210-224 are directed to and teach benefit matching for people.

(ii) Claims 225, 228, 232-247, 250, 254-268 are directed to and teach benefit matching for businesses, governments, educational institutions, non-profit organizations (i.e. non-human entities).

(iii) Claims 270-272 are directed to and teach benefit matching for all entity types.

B. Per § 41.37(c)(1): Unrepresented/pro se inventor/appellant is exempt from having to supply a concise explanation of the invention defined in the claims involved in the appeal.

2. Re Answer p.3-4, #1 & 2; *Specification*; please see p.3, #2 of Brief.

3. Re Answer p.4, #3; *Claim Objections*; please see p.3, #3 of Brief:

4. Applicant notes that the Answer appears to not have a number "4" (p.4). Applicant requests that Examiner notify applicant whether or not there is a number 4, and if so, what it is; so that applicant may properly address it.

5. Re Answer p.4, #5-6; please see p.4, #4 of Brief

6. Re Answer p.5, #8-9; please see no less than p.4-13, #5-14 of Brief.

7. Re Answer p.6-7, #11-14; please see no less than p.11-13, #14 of Brief.

8. Re Answer p.7, #15; please see no less than p.13, #15 of Brief.

9. Re Answer p.7, #16-17; please see no less than p.13-14, #16 of Brief.

10. Re Answer p.8, #18-19; please see no less than p.14-15, #17 of Brief.

Furthermore, because Examiner has not in the Answer supported the taking of Official Notice as required by at least 37 CFR 1.104(d)(2) and MPEP 2144.03(A) when contested by Applicant as is the case here; even for this reason alone claims 189, 211, 233, and 255 should also be allowed.

11. Re Answer p.8, #20; please see no less than p.15-16, #18 of Brief.
Furthermore, because Examiner has not in the Answer supported the taking of Official Notice as required by at least 37 CFR 1.104(d)(2) and MPEP 2144.03(A) when contested by Applicant as is the case here; even for this reason alone claims 190, 212, 234, and 256 should also be allowed.

- 12. Re Answer p.8, #21; please see no less than p.16-17, #19 of Brief.
- 13. Re Answer p.8-9, #22; please see no less than p.17-18, #20 of Brief.
- 14. Re Answer p.9, #23; please see no less than p.18-19, #21 of Brief.
- 15. Re Answer p.9, #24; please see no less than p.19-20, #22 of Brief.
- 16. Re Answer p.9, #25; please see no less than p.20, #23 of Brief.
- 17. Re Answer p.9, #26; please see no less than p.20-21, #24 of Brief.
- 18. Re Answer p.10, #27-28; please see no less than p.21-22, #25 of Brief.
- 19. Re Answer p.10, #29; please see no less than p.22-23, #26 of Brief.
- 20. Re Answer p.10, #30; please see no less than p.23-24, #27 of Brief.
- 21. Re Answer p.10, #31-32; please see no less than p.24-25, #28 of Brief.
- 22. Re Answer p.11, #33-34; please see no less than p.25-26, #29 of Brief.
- 23. Re Answer p.11, #35-37; please see no less than p.26-27, #30 of Brief.
- 24. Re Answer p.13, #1; *Response to Argument*; please see no less than p.29-31, #35 of Brief.
- 25. Re Answer p.13-14, #2; please see no less than p.31-32, #36 of Brief.
- 26. Re Answer p.14, #3-4; please see no less than p.32-33, #37 of Brief.
- 27. Re Answer p.14, #5; please see no less than p.33, #38 of Brief.
- 28. Re Answer p.14, #6-7; please no less than p.34, #40 of Brief.
- 29. Re Answer p.14-17, #8-9/10:

A. First, Examiner has misconstrued Appellant's position. Appellant has not just made the Examiner-listed arguments (those which are applicable [see "B," following] i.e. unexpected results) that the *independent* claims are unobvious and patentable, but that *all* the claims; both independent *and dependent*; are unobvious and patentable over the cited, supposed/alleged reference (Appellant noting that there are no [supposed/alleged] "*references*," [plural]; but just one--"PMA").

B. Second, please note that Appellant has not made any *synergism, multiplicity of steps, or references teach away* arguments.

30. Re Answer p.14-17, #8-9/10; Examiner has here merely listed some of Appellant's arguments (unexpected results, objective evidence, commercial success, solution of long-felt need, and competitive recognition) along with a cursory copying of various parts of Chapter 700 of the MPEP ("*To Be Of...*" "*Attorney Arguments...*," "*Burden On...*," and "*Evidence Of...*")."

Yet; doing so does not constitute the well-settled requirement to present reasoned arguments separately arguing any Examiner contention(s) of the obviousness of the invention. Absent such reasoned arguments; since the Examiner has not set forth any basis on which to reject any of these five separate, distinct, and unique Appellant grounds of non-obviousness; Examiner's rejection of the independent claims and the claims dependent thereon should even for these reasons alone be reversed.

"Only the arguments made by Appellant (here, Examiner) in the Brief (and Reply Brief) (here, Answer) will be considered and that failure to make an argument constitutes a waiver on that particular point. Support for this rule has been demonstrated by our reviewing court in In re Berger, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002), wherein the Federal Circuit Court stated that because the Appellant (here, Examiner) did not contest the merits of the rejections (here, Appellant arguments) in his brief (here, Answer) to the Federal Circuit court, the issue is waived." (parenthesis supplied)

And as was forcefully stated in *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); "*We will not resort to speculation as to the examiner's position.*"

31. Furthermore, even if Examiner's mere listing of some of Appellant's arguments and sections of the MPEP constituted meritorious argument for obviousness of the instant invention; which Appellant vehemently disputes and contests is the case:

"The general rule is that administrative agencies like the PTO are not bound by the rules of evidence that govern judicial proceedings." In re Epstein, 32 F.3d 1559, 1565, 31 USPQ2d 1817, 1821 (Fed. Cir. 1994).

and:

“Evidence of advantages or unexpected results produced by the invention may be established by affidavit or declaration under 37 CFR 1.132 or may be submitted in unsworn form in the written description or in a reply to a rejection.” See *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995); and *Formulating and Communicating Rejections Under 35 U.S.C. 103 For Applications Directed to Computer-Implemented Business Method Inventions*; Section III-B; *Rebuttal of the prima facie case*; (<http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm#IIIB>) See also MPEP 2145; *Consideration of Applicant's Rebuttal Arguments*

Both of these two above authorities even further supporting that Appellant's well-reasoned arguments throughout these proceedings should be given the full probative value for which they each clearly qualify for.

“Office personnel should consider all rebuttal arguments and evidence presented by applicants.” See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 MPEP 2145

“Consideration of rebuttal evidence and arguments requires Office personnel to weigh the proffered evidence and arguments.” *In re Alton*, 76 F.3d 1168, 1174-75, 37 USPQ2d 1578, 1582-83 (Fed. Cir. 1996) MPEP 2145

Additionally, it is well settled that where information and facts are obvious to the public in general; and especially so when obvious to those in the art (most) applicable to a given invention; there is no legal need or requirement for affidavits or declarations for such information and facts to be of probative value. That water is wet, a diamond hard, or the sky blue does not require affidavits or declarations to make them “probatively” so.

Specifically; the previously referenced and exhibits-provided, wildly-successful GovBenefits and BenefitsCheckUp operating embodiments of the present invention clearly demonstrate Unexpected Results, Commercial Success, and Solution of Long-Felt Need; with the additional well-known fact that the national media has for many decades now shared--in both general/aggregate form, and through individual stories--the difficult

and painful realities of individuals and families in distress; yet not knowing where to go or who to turn to for all the help and assistance which may be available to them.

Husbands and wives out of work. No food in the house. Sick kids who's parents have no way to pay for their medical care. Families living on the streets. This is not a question of whether or not some new crease, bend, or dimple added to some prior art object solves some obscure, supposedly long-felt need. No. Here, the long-felt need—which the instant invention obviously solves—is most assuredly unquestioned and therefore also entitled to its full probative value for this reason as well.

Rebuttal evidence may include evidence that the claimed invention was copied by others. See, e.g., In re GPAC, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); Hybritech Inc. v. Monoclonal Antibodies, 802 F.2d 1367, 1380, 231 USPQ 81, 90 (Fed. Cir. 1986)

32. In addition, note that Appellant has also presented a full five additional [which five includes Competitive Recognition; listed on p.15, #8 of Answer] well-reasoned arguments in the Appeal Brief for the invention's non-obviousness which do not even fall under the listed categories [unexpected results, commercial success, solution of long-felt need, etc] of the Examiner-referenced MPEP "I" (p.15); namely, (1) Competitive Recognition, (2) Assumed Insolubility, (3) New Principle of Operation, (4) Different Problem Solved, and (5) Lack of Implementation.

33. Therefore; as these five arguments require no affidavits nor declarations to be of probative value; Examiner having not set forth any meritful basis to traverse any of these five arguments (*In re Berger*, supra; *In re Warner*, supra.); and Appellant having set forth a reasoned basis for each of these five arguments; Appellant has therefore overcome any possible prima facie case of obviousness (which prima facie case Appellant vehemently disputes and contests even exists). Accordingly, the rejection of the claims at issue in this appeal should even for these reasons alone be thusly reversed.

34. Furthermore, Appellant's Brief and Reply Brief most certainly establish that the results are unexpected and unobvious and of both statistical and practical significance. Now helping millions of people each and every year, could anyone reasonably doubt that the breakthrough, exploding popularity GovBenefits.gov service is anything but one the most ingenious, most easy to use, most socially important, most useful and valuable services—online or off—that we'll ever see in our lifetimes? Unexpected? Unobvious? Of statistical and practical significance? Yes! Yes! And double yes! Millions and millions of thrilled, lives-now-improved people (plus reduced state and federal expenditures) can't be wrong. The proof is indeed in the pudding.

35. Still furthermore, commercial success most certainly is commensurate with the scope of the independent claims as interpreted in light of the specification. Indeed; since the Patent Office has, after careful review and consideration, made this application special based on infringement by the GovBenefits (and BenefitsCheckUp) services; and appellant has supplied proof of the great and substantial success (including Exhibit C) of the two infringing services, a clear nexus between the independent claims of the instant invention and commercial success has been both established by Appellant AND confirmed and established by the PTO itself; demonstrating once again the non-obviousness of the present invention.

36. Since Appellant is pro se; and therefore no attorney/counsel statements are being made, "II. Attorney Arguments Cannot Take the Place of Evidence" (Page 15 of Answer) is obviously moot.

37. However, note that even if any of the above grounds for the non-obviousness of the instant invention weren't accorded the full probative value for which they are clearly entitled; which Appellant vigorously and vehemently maintains should be the case; all these many and varied Appellant grounds would still possess and provide their full probative value under the applicable section of 716.01(c) "III," as follows:

716.01(c) Probative Value of Objective Evidence [R-2]

III. OPINION EVIDENCE

“Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive.” (emphasis supplied) *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) See also *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) (“Although an affiant's or declarant's opinion on the ultimate legal issue is not evidence in the case, ‘some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him.’” 385 F.2d at 456, 155 USPQ at 524 (emphasis in original)).

See also, for example, *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953); where arguments of an applicant as to the advantages of his or her claimed invention cannot be disregarded for this reason alone.

See also *In re Epstein*, *supra*; *In re Formulating and Communicating Rejections . . .*, *supra*.

While it's recognized that Applicant has an obvious interest in the outcome of this appeal; such interest in no way negates the supplied overwhelming contentions, arguments, factual support and reasonings in support of Applicant's position regarding the present invention's unobviousness. Moreover, Examiner neither provides any arguments against nor offers any evidence of any type in opposition to that of applicant's contentions and assertions.

Therefore, since Examiner has not set forth any basis to nullify or traverse appellant's substantial evidence of unobviousness (*In re Berger*, *supra*; *In re Warner*, *supra*); while Appellant has most certainly established the instant invention's unobviousness; the present invention is non-obvious and the rejection of the claims at issue here should even for these reasons alone be overturned.

38. Re Answer p.17, #10-11: In view of this/these argument(s) being stated by Examiner as being directed to previously cancelled claims 1, 80, 164, 169, and 176; which are not at issue; the argument(s) contained in #10 and #11 are accordingly moot. *In re Berger*, *supra*; *In re Warner*, *supra*.

Furthermore, even if the intent was [or would be] to direct such argument(s) to the independent and/or dependent claims of the claimed invention which is the actual object of these current proceedings, Appellant has already addressed and overcome any and all such argument(s) in the Appeal Brief and/or this Reply Brief (e.g.; in no less than #30-32 above).

39. For all the many wide, varied, and substantial reasons above, in Appellant's Brief, this Reply Brief, and throughout its prosecution; even if based on the record as a whole (which Appellant vigorously and vehemently contests and disputes is even necessary given the clear lack of either a factual or prima facie case of either anticipation or obviousness having been established); given Appellant's overwhelming case verses Examiner's very weak case; Appellant's instant invention is clearly neither anticipated nor unobvious; and the claims at issue in this appeal should even for this reason alone be allowed.

Conclusion

Respectfully, the Answer has changed nothing. Examiner's arguments still fall far short. Indeed, with numerous grounds being present for overturning each and every one of the rejections, the case for the present invention's novelty and unobviousness remains unassailable. Accordingly, it is submitted that the still remaining claims should also be allowed; which Appellant respectfully requests.

"It is usually, if not indeed always, easy to discover a genesis somewhere for any patentee's contribution. A thought expressed here, a hint appearing there, and a suggestion made somewhere else can always be found, after the event, and assembled to support the contention that what the patentee did was really nothing but what anyone else might do if so inclined. But if patents were to be held invalid on such reasoning, few would survive. Even the greatest invention of all time, the wheel, had, we are told, its prior art of unnumbered savages slipping on round stones. How many slipped before some bruised genius among them literally fell upon the principle of the roller, and how many more years, or centuries, passed before some succeeding genius, building upon the prior art of rollers, thought of a fixed pivot and invented the wheel, can only be surmised." S.D. Warren Co. v. Nashua Gummed & Coated Paper Co., 205 F.2d 602, 605 (1st Cir. 1953)

As demonstrated well with over 100,000 being issued each year in the United States; respectfully; one does not have to create an invisibility machine or turn lead into gold in order to receive a patent. Applicant's invention meets all the conditions and requirements to receive a patent and join these 100,000+ others in 2008. 35 U.S.C. 101

In closing, I would like to thank the Board and office personnel in advance for their work on this appeal; while standing ready to address any matter that is deemed appropriate by the Board to reach a reasoned decision on this appeal. I also wish to express my appreciation to the hard-working Examiners who've worked with me during this prosecution. Though we obviously have very different viewpoints on the patentability of the present invention, they've always been helpful to me along the way; conducting themselves at all times in a friendly, professional manner.

Very respectfully submitted,

A handwritten signature in black ink that reads "Steve Morsa". The signature is written in a cursive, slightly slanted style.

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